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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,623	09/26/2001	David C. Halliday	18707-13	2492

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EXAMINER

SHERR, CRISTINA O

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 07/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/965,623	<b>Applicant(s)</b> HALLIDAY ET AL.	
	<b>Examiner</b> Cristina O Sherr	<b>Art Unit</b> 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2001.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This communication is in response to the application filed 26 September 2001.

Claims 1-20 have been examined in this case.

#### ***Priority***

2. Applicant claims priority to U.S. Provisional Application No. 60/235479 filed 26 September 2000.

#### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

#### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-6 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 6,658,568B1).
6. Regarding claim 1 –

Ginter discloses a method of enabling fee based access to one or more software applications, comprising: establishing a user account with a billing site which responds to input user information and correspondingly debits the user account; obtaining an application package for use on a client computer, the application package including a metering monitor, a login tool, one or more client applications, and an application library having metering means for developing information relating to usage of said client applications; using said login tool to establish communication with said user account at said billing site; using said metering means to obtain and communicate to said metering monitor usage a information relating to usage of said client applications on said client computer; using said metering monitor to communicate said usage information to said user account at said billing site; and using the usage information to debit said user account (e.g. col 4 ln 60 –col 5 ln25).

7. Regarding claim 2 –

Ginter discloses a method as recited in claim 1 wherein said user obtains said application package from a software proprietor (e.g. col 19 ln 50-65).

8. Regarding claim 3 –

Ginter discloses a method as recited in claim 2 wherein said application package is contained on a data storage medium included in the group consisting of magnetic storage tapes, magnetic storage disks, optical data storage disks, optical data storage disks, and electronic data storage cards (e.g. col 21 ln 15-25).

9. Regarding claim 4 –

Ginter discloses a method as recited in claim 2 wherein said user obtains said application package by downloading it from a software proprietor's website (e.g. col 21 ln 30-55).

10. Regarding claim 5 –

Ginter discloses a method as recited in claim 1 wherein said application package further includes a configuration file, and wherein on startup of a client application, said login tool is used to update said configuration file and identify the user to the billing site (e.g. col 28 ln 15-60).

11. Regarding claim 6 –

Ginter discloses a method as recited in claim 1 wherein on login said billing site communicates or withholds authorization to run said client application based upon the state of the user's account (e.g. col 27 ln 30-65).

12. Claims 7-15 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 6,658,568B1).

13. Regarding claim 7 –

Ginter discloses a system for providing fee based access to one or more software applications and for remotely monitoring use thereof, comprising: means forming a billing site having a database for storing user account information, communication means for receiving application usage data, and means for processing the usage data, attributing a cost to said usage data, and debiting said cost to a corresponding user account in said database; a client computer communicatively associated with said billing site; and an application package installed on said client computer, said application

package including a metering monitor, a login tool, one or more client applications, and an application library having metering means for developing information relating to usage of said client applications; wherein said login tool is used to establish communication with a user account at said billing site, said metering means is used to obtain and communicate usage information relating to usage of said client applications to said metering monitor, and said metering monitor is used to communicate said usage information to said user account (e.g. col 4 ln 60 –col 5 ln25).

14. Regarding claim 8 –

Ginter discloses a system as recited in claim 7 wherein said application package further includes a configuration file, and wherein on startup of a client application, said login tool is used to update said configuration file and identify the user to the billing site (e.g. col 19 ln 50-65).

15. Regarding claim 9 –

Ginter discloses a system as recited in claim 8 wherein said metering monitor is used to identify the software application in use by said client computer (e.g. col 21 ln 15-25).

16. Regarding claim 10 –

Ginter discloses a system as recited in claim 7 wherein said metering monitor generates and communicates to the billing site a user map that identifying every user currently running a client application on said client computer (e.g. col 21 ln 30-55).

17. Regarding claim 11 –

Ginter discloses a system as recited in claim 10 wherein said metering monitor also generates a job map that maps the local identity of a running client application to a

single number allocated by said billing site and to the user to which the running client application belongs (e.g. col 28 ln 15-60).

18. Regarding claim 12 –

Ginter discloses a system as recited in claim 7 wherein all user information communicated between said metering monitor and said billing site is encrypted (e.g. col 28 ln 15-60).

19. Regarding claim 13 –

Ginter discloses a system as recited in claim 7 wherein said metering monitor keeps track in a pending feature table, all features being used by said client applications (e.g. col 28 ln 15-60).

20. Regarding claim 14 –

Ginter discloses a system as recited in claim 13 wherein said pending feature table is stored on a persistent storage means for recovery in the event of a system failure (e.g. col 27 ln 30-65).

21. Regarding claim 15 –

Ginter discloses a system as recited in claim 7 wherein a timing means is used to cause said metering monitor to perform periodic connection checks to determine whether or not any running client applications have unexpectedly terminated without reporting their status (e.g. col 27 ln 30-65).

22. Claims 16-19 are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 6,658,568B1).

23. Regarding claim 16 –

Ginter discloses an application package for installation on a client computer, comprising: a metering monitor, a login tool, one or more client applications, and an application library having metering means for developing information relating to usage of said client applications; wherein said login tool is used to establish communication with a user account at a billing site, said metering means is used to obtain and communicate to said metering monitor usage information relating to usage of said client applications, and said metering monitor is used to communicate said usage information to said user account at said billing site (e.g. col 4 ln 60 –col 5 ln25).

24. Regarding claim 17 –

Ginter discloses a system as recited in claim 16 wherein said metering monitor is also used to identify the software application in use by said client computer (e.g. col 19 ln 50-65).

25. Regarding claim 18 –

Ginter discloses an application package as recited in claim 16 further comprising a configuration file for storing configuration parameters that enable correct operation of a system using the application package (e.g. col 21 ln 15-25).

26. Regarding claim 19 –

Ginter discloses an application package as recited in claim 18 wherein on login said metering monitor grants or withholds authorization to run said client application based upon the state of the user's account (e.g. col 27 ln 30-65).

27. Claim 20 is are rejected under 35 U.S.C. 102(e) as being anticipated by Ginter et al (US 6,658,568B1).

Art Unit: 3621

28. Ginter discloses an application package for installation on a client computer, comprising: a login tool, one or more client applications, and an application library having metering means for developing information relating to usage of said client applications and a metering monitor; wherein said login tool is used to establish communication with a user account at a billing site, said metering means is used to obtain and communicate to said metering monitor usage information relating to usage of said client applications, and said metering monitor is used to communicate said usage information to said user account at said billing site (e.g. col 4 ln 60 –col 5 ln25).

29. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### ***Conclusion***

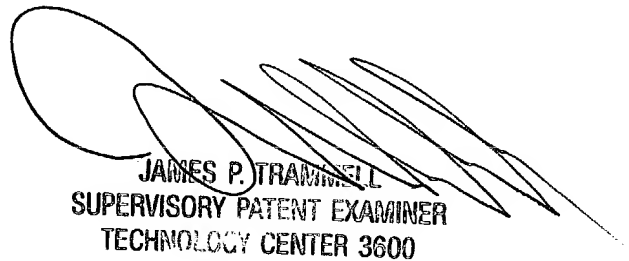
30. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

Art Unit: 3621

31. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

32. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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